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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,368	12/12/2003	Per Sauerberg	6594.200-US	2809
23650	7590	11/27/2007		
NOVO NORDISK, INC. PATENT DEPARTMENT 100 COLLEGE ROAD WEST PRINCETON, NJ 08540			EXAMINER KEYS, ROSALYND ANN	
			ART UNIT	PAPER NUMBER
			1621	
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/734,368

Applicant(s)

SAUERBERG ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48, 53-66 and 69-73 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54, 63-66 and 69 is/are rejected.
- 7) ☒ Claim(s) 58, 59 and 61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-8,12-15,23,25,29-31,35-37,53,55-57,60,62 and 70-73.

## **DETAILED ACTION**

### *Status of Claims*

1. Claims 1-48, 53-66, 69-73 are pending.  
Claims 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54, 63-66 and 69 are rejected.  
Claims 5-8, 12-15, 23, 25, 29-31, 35-37, 53, 55-57, 60, 62 and 70-73 are withdrawn from consideration.  
Claims 58, 59, and 61 are objected.  
Claims 49-52, 67, are 68 are cancelled.

### **Election/Restrictions**

2. Claims 5-8, 12-15, 23, 25, 29-31, 35-37, 53, 55-57, 60, 62 and 70-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 20, 2006.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter

sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54, 63-66 and 69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sauerberg et al. (WO 01/79150 A1) alone or in view of Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al. (US 6,200,995 B1).

Sauerberg et al. teach the claimed invention at page 3, line 16 to page 4, line 4; page 8, line 1 to page 10, line 3; page 15, line 20 to page 16, line 15; and page 17, lines 23-31. In the compound of general formula (I) the Y substituent corresponds to T-Z-U in the instant compound of formula (I). Sauerberg et al. disclose that Y is alkylaralkyl (see page 3, line 28). Examples of alkyl include methyl, ethyl and isopropyl (see page 4, lines 29 and 30). Examples of aryl include naphthyl (see page 5, lines 21-23). This naphthyl reads upon amended substituent Z, i.e. a

divalent polycyclic ring-system. The Examiner believes that the instant compound would be envisaged by the ordinary skilled artisan based upon the teaching of Sauerberg et al. Thus, the instant claims are anticipated. Sauerberg et al. is also suggestive of using other divalent polycyclic ring-systems, since Sauerberg et al. teach that by aryl is meant groups like naphthyl (see page 5, lines 21-23 and page 6, lines 1-3).

Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al. (US 6,200,995 B1) each relate to compounds which are PPAR agonists or modulators (see entire disclosures, in particular the background of invention for each reference).

De la Brouse-Elwood et al. define aryl to mean phenyl, 1 or 2-naphthyl, 4-biphenyl, etc. (see column 4, lines 12-34).

Pershadsingh et al. define aryl to mean phenyl, naphthyl, biphenyl, etc. (see column 5, lines 1-16).

One having ordinary skill in the art at the time the invention was made would reasonably have believed that the phrase or the like as disclosed by Sauerberg et al. would include biphenyl or other divalent polycyclic ring-systems as disclosed by Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al., since these were common aryl substituents for compounds which are PPAR modulators or agonists.

### **Response to Amendment**

#### Specification

8. The title of the invention is now descriptive.

#### Claim Rejections - 35 USC § 112

9. The rejection of Claims 66 under 35 U.S.C. 112, second paragraph, is withdrawn, due to the amendment to claim 66, filed September 6, 2007.

Claim Rejections - 35 USC § 102

10. The rejection of claims 49-52, 67 and 68 under 35 U.S.C. 102(b) as being anticipated by Sauerberg et al. (WO 01/79150 A1) is withdrawn, since these claims have been cancelled.

11. The previous rejection of Claims 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26, 27, 32, 33, 38-48, 63-66 and under 35 U.S.C. 102(b) as being anticipated by Sauerberg et al. (WO 01/79150 A1) is withdrawn, due to the amendment to claims 1 and 48. However, the claims are still unpatentable because the amendment to substituent Z still reads upon the Sauerberg et al. reference as explained above.

Claim Rejections - 35 USC § 103

12. The previous rejection of claims 18, 21, 28 and 34 under 35 U.S.C. § 103(a) as unpatentable over Sauerberg et al. (WO 01/79150) is withdrawn, due to the amendment to claim 1.

**Response to Arguments**

Specification

13. Applicant's arguments, see point (2) on page 23, filed September 6, 2007, with respect to the objection to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.

Claim Rejections - 35 USC § 102

14. Applicant's arguments, see point (5) on page 24, filed September 6, 2007, with respect to the rejection under 35 U.S.C. 102(e) as being anticipated by Sauerberg et al. (US 2003/0109579 A1) have been fully considered and are persuasive. The rejection of claims 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26, 27, 32, 33, 38-52, 54, 63-69 has been withdrawn.

Claim Rejections - 35 USC § 103

15. Applicant's arguments, see point (7) bridging pages 24 and 25, filed September 6, 2007, with respect to the rejection under 35 U.S.C. 103(a) as being obvious over Sauerberg et al. (US 2003/0109579 A1) have been fully considered and are persuasive. The rejection of claims 18, 21, 28 and 34 has been withdrawn.

**Allowable Subject Matter**

16. Claims 58, 59 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, R & F 5:30-7:30 am & 1-5 pm; T & W 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rosalynd Keys/  
Primary Examiner  
Art Unit 1621

November 20, 2007